

when the instant continuation application was filed, by virtue of the stamped postcard listing the complete copy of the '124 application. The parent application (09/515,124), was retrieved from the PTO file and does in fact, contain missing pages 53 and 54. A copy of this '124 application was included in the original petition. The Petitions Examiner dismissed the petition on May 20, 2002.

In the Dismissal, the Petitions Examiner was not persuaded by Applicant's evidence that the continuation application was filed with the missing pages, which consisted of, *inter alia*, copies of the PTO stamped postcard identifying that applicants had provided a copy of the specification of the parent application as filed. The Petitions Examiner stated that the postcard receipt for this application merely set forth the applicant's intent to file a copy of the prior application because the postcard did not indicate that the specification contained 166 pages. Therefore, according to the Petitions Examiner, the postcard did not qualify as *prima facie* evidence of receipt of the entire specification at the USPTO under MPEP 503.

On June 19, 2002, Applicants filed a reply to the Decision Dismissing the Petition For a Filing Date in response to the Notice of Omitted Items in a Nonprovisional Application. Based upon this reply, the Petitions Examiner dismissed the petition as moot on November 19, 2002. In this second dismissal, the Petitions Examiner pointed out that under MPEP 201.06(c), an amendment can be submitted to add the missing pages of the specification if the requirements of that section are met. In particular, the Petitions Examiner stated that since this application has been accorded a filing date, "the issue will

not be decided on petition under 37 CFR 1.53(e), but instead the proposed inclusion of the missing pages by way of amendment." (Dismissal, p. 2)

The relevant portions of MPEP § 201.06(c) are as follows:

In a continuation application or divisional application, the safeguard (petition and fee under former 37 CFR 1.60(b)) concerning the filing of an application lacking all of the pages of the specification or sheets of drawings of the prior application has not been retained in 37 CFR 1.53(b) since the specification and drawings of a continuation or divisional application are not limited to a reproduction or a "true copy" of the prior application. As a safeguard, however, an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The incorporation by reference statement can only be relied upon to permit the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference...for the incorporation by reference to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or transmittal letter-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application...

The requirements of this section are that (1) Applicants properly incorporated the missing portion of the prior application (pages 53 and 54) in the specification as filed or transmittal letter as filed, and (2) that the continuation application is entitled to a filing date notwithstanding the incorporation by reference. Applicants respectfully submit that they have complied with these requirements of MPEP § 201.06(c).

On March 27, 2001, a Preliminary Amendment was filed amending the specification to read as follows:

This is a continuation of U.S. Serial No. 09/515,124, filed February 27, 2000, entitled "Compositions and Methods for Non-Targeted Activation of Endogenous Genes," naming John J. Harrington, Bruce Sherf, and Stephen Rundlett as inventors, which is a divisional application of U.S. Application No. 09/276,820, filed March 26, 1999, which is a continuation-in-part of U.S. Application No. 09/263,814, filed March 8, 1999, which is a continuation-in-part of U.S. Application No. 09/253,022, filed February 19, 1999, which is a continuation-in-part of U.S. Application No. 09/159,643, filed September 24, 1998, which is a continuation-in-part of U.S. Application No. 08/941,223, filed September 26, 1997, the disclosures of all of which are incorporated herein by reference in their entireties.

Based upon this Preliminary Amendment, Applicants show that the specification properly claimed priority to related applications and incorporated the disclosures of all by reference in their entireties. Further, as stated above, the parent '124 application contains the missing pages 53 and 54. Therefore, the first requirement of MPEP § 201.06(c) is satisfied. Furthermore, the '897 application is entitled to its January 17, 2001 filing date notwithstanding the missing pages 53 and 54. Inspection of the missing pages show that these pages are at the beginning of the detailed description section of the specification, and provide only a general description by the Applicants, of cells made using the invention of various species of eukaryotes and preferred cell lines, and general methods of derivation and use of these cells. The detailed description continues for another 100 pages, and the actual examples of embodiments do not begin until page 119 of the specification. These missing pages are not critical for the claimed invention, and therefore, Applicants have satisfied the second requirement of MPEP § 201.06(c).

As such, Applicants respectfully request the Examiner amend the specification of the '897 application to include pages 53 and 54 of the parent '124 application. With the

addition of these pages, this amendment accords the '897 application its original filing date of January 17, 2001.

Prompt and favorable consideration of this amendment in the prosecution of the above-noted application is respectfully requested.

Respectfully submitted,

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